

REMARKS

This amendment is submitted in response to the Office Action dated October 3, 2005. No new matter has been added, and the amendments place the claims in better condition for allowance.

CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

In the present Office Action, Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended the claims to overcome the § 112 rejection, and Applicant respectfully requests reconsideration of the rejection in light of the amendment. Applicant thanks the Examiner for his attention to detail.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In the present Office Action, Claims 1-3, 7-10, 12, 14-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,469,854 to Gill, *et al.* (*Gill*) in view of U.S. Patent No. 5,394,280 to Chliwnyj *et al.* (*Chliwnyj*). Those rejections are respectfully traversed in view of the discussion made herein, and favorable reconsideration of the claims is requested.

L. The step of 'changing a location' as claimed in exemplary Claim 1 is not taught or suggested.

As set forth in MPEP § 2142, "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Applicant respectfully submits that the combination of references supplied by the Examiner does not teach or suggest all the claim limitations of Applicant's invention as recited in exemplary amended Claim 1.

With respect to exemplary amended Claim 1, Applicant respectfully submits that the cited combination of references does not teach or suggest Applicant's claimed feature of "a write-area changing unit for changing a location on said data recording medium of data from said

additional block, wherein said write-area changing unit writes said data of said additional block, excluding said validity information of said additional block, to said error area and writes said validity information of said additional block to an area of said data recording medium other than said error area". The Examiner correctly states at page 4 that "Gill et al fails to specify that the write-area changing unit changes the location of an additional block (considered as block previous to the single block)." The Examiner then states: "Chliwnyj et al discloses teaching to changing the location of additional block as claimed (see figs. 9-10 disclosure thereof and col. 7 lines 29-68)." Applicant respectfully disagrees. The cited text of *Chliwnyj* discloses:

FIGS. 9 and 10 show demarking a servo defect 165 that is sufficiently close to block N-1 150 such that an SDB cannot be written in area 166 between block 150 and dropout. 165. The longitudinal extent of dropout. 165 is measured as shown in FIG. 8. The longitudinal tape distance between a trailing end 167 of data block N-1 150 and dropout 165 can be determined in one of two ways. First, a physical location of trailing end 167 and the physical location of leading location of dropout 165 can be subtracted for measuring the longitudinal extent of area 166. If the measurement indicates an insufficient longitudinal extent then the below-described procedure is used. Second, an SDB can be created and attempted to be written as shown in FIG. 8. If the SDB writing encroaches on dropout 165, then the writing is aborted indicating an insufficient longitudinal extent in area 166 for any SDB.

After either of the above-described procedures indicate insufficient space, then tape 21 and head 27 are relatively positioned to read data block N-1 159. The contents of data block N-1 159 are temporally stored in RAM 29 of tape drive 10. SDB 170 is then written over the data block N-1 copy on tape 21 as seen in FIG. 10. The leading edge 169 of SDB 170 begins at the same location that data block N-1 began. This positioning preserves an expected IBG between a data block N-2 (not shown) that was longitudinally adjacent to overwritten data block N-1. Then tape 21 and head 27 are relatively repositioned to be near trailing end 175 of dropout 165. Then tape drive 10 writes SDB 171 on tape 21 as seen in FIG. 10. Data block N-1 stored in RAM 29 is then written to tape 21 at 173 (FIG. 10) separated from SDB 171 by a usual IBG. The SDB's 170 and 171 have the double-linking pointers 172 as described for SDB's 160-161. Data block N is then written to tape 21 in area 174 after data block N-1 173 was written. Usual recording operations then ensue. All of the blocks 167, 170, 171 and 173 are in track group 3 while defect 165 may affect not only the servo track areas 40-41 but all of the track groups 0-3.

Upon a close reading of this text, Applicant respectfully submits that *Chliwnyj* discloses a process of overwriting valid data block (*i.e.*, N-1) with a servo dropout block (SDB). No content is placed in the error area marked by *Chliwnyj*'s SDBs.

In applicant's invention, as recited in exemplary claim 1, by contrast, an error location is overwritten with data in the error area. This is clearly stated by recitation of "a write-area changing unit for changing a location on said data recording medium of data from said additional block, wherein said write-area changing unit *writes said data of said additional block*, excluding said validity information of said additional block, *to said error area* and writes said validity information of said additional block to an area of said data recording medium other than said error area" in exemplary claim 1. Applicant respectfully submits that *Chliwnyj* neither teaches nor suggests "a write-area changing unit for changing a location on said data recording medium of data from said additional block, wherein said write-area changing unit *writes said data of said additional block*, excluding said validity information of said additional block, *to said error area* and writes said validity information of said additional block to an area of said data recording medium other than said error area".

II. No specific teaching of a motivation to combine is cited with respect to Claim 1

As set forth in MPEP 2143, the first criterion for establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to...combine reference teachings." In evaluating motivation or suggestion to combine reference teachings, "a prior art reference must be considered in its entirety, *i.e.*, as a whole" (emphasis in original). MPEP 2141.02, citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983) *cert. denied*, 469 U.S. 851 (1984). In view of the teachings of the references as taken as a whole, it is apparent that there is no objective suggestion or motivation in the cited references (or generally in the art) that would lead a skilled artisan to combine the reference teachings to obtain the present invention. If such suggestion or motivation existed, the Examiner would have, no doubt, cited by column and line number a passage in one of the references cited or a well known teaching in the art to discharge his duty to "explain why the combination of the teachings is proper." MPEP 2142, citing *Ex parte Skinner*,

2 USPQ2d 1788 (Bd. Pat. Appl. & Inter. 1986). Instead, at page 5 of the present office action, the Examiner asserts:

It would have been obvious to one of ordinary skill in the art at the time this invention was made to modify the storage apparatus disclosed by Gill et al with the above teachings of Chliwnyj et al to provide a capability of changing the location of the additional data previous to the single block in order to preserve the expected gap between the data blocks and the error are and hence prevent the loss of data as taught by Chliwnyj et al.

Applicant respectfully disagrees that one skilled in the art would be motivated to combine the references to create Applicant's invention, both because no objective motivation to combine is provided by the cited references and because the cited combination would not result in Applicant's invention. Because the Examiner's combination of references is not supported by any citation to objective teaching in the references or art, Applicant believes that the examiner has failed to establish a *prima facie* case of obviousness.

III. Arguments with respect to Claim 1 apply broadly

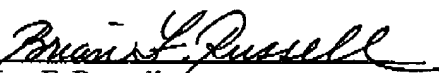
Applicant respectfully submits that the rejection of exemplary Claim 1 under 35 U.S.C. § 103 is overcome. The foregoing arguments made with respect to Claim 1 are also made with respect to Claims 2-7, which further limit and patentably distinguish Claim 1. The foregoing arguments are also made with respect to Claims 8 and 15, which claim a method and a computer program product for performing Applicant's invention, respectively. The foregoing arguments are similarly made with respect to Claims 9-14, which further limit and patentably distinguish Claim 9 and with respect to Claims 16-20, which further limit and patentably distinguish Claim 15.

CONCLUSION

Applicants have diligently responded to the Office Action by amending the claims to overcome the objections and § 103 rejections, and to clarify features within specific claims. Applicants have also provided discussion/arguments which show why Applicants' claims are not anticipated by not obvious in light of the references provided. Because the amendments and arguments overcome the objections and § 103 rejections, Applicants, respectfully request issuance of a Notice of Allowance for all claims now pending.

Applicant further respectfully requests the Examiner contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,


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